

REMARKS

Claims 29-54 are pending in the application.

Claims 51-54 are rejected.

Claim 51 is amended.

Reconsideration and allowance of claims 51-54 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §102

Claims 51-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunimoto et al (U.S. Patent No. 7,160,643) (Kunimoto). This rejection is not applicable to the amended claims.

Claim 51 includes: a chassis; a battery bay formed in the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly including a first plurality of batteries and having a mating surface member including a first pattern for mating engagement with a second subassembly including a second plurality of batteries and having a mating surface member including a second pattern, which is an inverse pattern to the first pattern, the patterns supporting battery cells within the subassemblies and also resisting relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

The argument presented by the USPTO with respect to Kunimoto is inadequate in many respects when considered in the light of 35 U.S.C. 102.

The chassis of the invention is housing 610, Fig. 6 having a bay 605 formed therein for receiving a removable battery assembly 100, Fig. 1. For comparison, assembly 100 can be referred to as a battery pack. However, the battery pack 70 of Kunimoto includes a lower casing portion 71, which contains no batteries, and upon which are positioned, or supported, a plurality of rows of batteries 10, each battery in the row being connected to an adjacent battery end-to-end. The USPTO refers to the Kunimoto battery subassemblies by reference numeral 10. The Kunimoto reference identifies 10 as being a battery which forms a battery pack. The invention refers to subassemblies as 200 and 300, each containing plural batteries. Thus, the USPTO refers to a battery assembly as a plurality of batteries 10 which the USPTO also refers

to as subassemblies. Therefore, the USPTO position is that each battery 10 is a subassembly of an assembly of batteries.

The USPTO has taken the position that lower casing portion 71 is a battery bay. However, lower portion 71 is a mere support for a plurality of interconnected batteries, an extremely broad interpretation of a battery bay. If the batteries were laying on a table, would the table be a battery bay?

In the invention, the battery assemblies 100 are comprised of battery subassemblies 200, 300. Each subassembly 200, 300 includes batteries 205, 305, respectively. Therefore, the question arises as to whether the USPTO regards each battery of Kunimoto as either a battery in a subassembly, or as a battery which is a subassembly. There must be either a battery as a part of a subassembly or a battery which is a subassembly, for a proper 102 reading of the claimed invention on Kunimoto. It cannot be read both ways to support the USPTO interpretation. In the invention, a subassembly clearly contains a plurality of batteries.

The USPTO then takes the position that the plurality of battery subassemblies 10 comprises "a first subassembly having a mating surface including a first pattern for mating engagement with a second subassembly having a mating surface including a second pattern, which is an inverse pattern to the first pattern, to resist relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly (see Figures 5 and 7 and column 9 lines 55-67 and column 10 lines 1-7)."

This is an interesting argument because Figs. 5 and 7, and column 9, line 55, to col. 10, line 7 are directed to the connectors 20. These connectors 20 are also illustrated at Figs. 9-12. However, the quote from above describes these as comprising the subassemblies 10. These connectors are neither batteries nor battery subassemblies. These connectors are provided for electrically connecting the batteries 10 and holder cap 30 so that the batteries 10 can be series connected and linearly interlocked.

Now comes the USPTO to take the position that the battery subassemblies 10 comprise a first subassembly and a second subassembly. Based upon the previous USPTO position, this would include a first battery and a second battery. Furthermore, in line with the position of the USPTO, the first battery would include a first pattern for mating engagement with a second battery having a mating surface including a second pattern, which is inverse to the first pattern.

In the invention, the subassemblies clearly each include plural batteries. Also, the claimed first and second inverse patterns formed in mating surfaces clearly support battery cells

within the subassemblies and clearly resist relative movement between the subassemblies. There is no such teaching or suggestion in any of the references.

The USPTO provides in MPEP §2131 that: "To anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejections with respect to claims 51-52, Kunimoto must contain all of the above-claimed elements. However, this patent does not disclose a chassis; a battery bay formed in the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly including a first plurality of batteries and having a mating surface member including a first pattern for mating engagement with a second subassembly including a second plurality of batteries and having a mating surface member including a second pattern, which is an inverse pattern to the first pattern, the patterns supporting battery cells within the subassemblies and also resisting relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

As a result, the previous rejection based on 35 U.S.C. 102(b) cannot be supported by Kunimoto as applied to independent claim 51 and its dependent claim 52.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunimoto, as applied to claims 51-52 above, and in further view of Verbrugge et al (U.S. Patent No. 7,324,902) (Verbrugge). This rejection is not applicable to the amended claims.

Kunimoto fails to provide an adequate platform for supporting the other references to establish a *prima facie* case of obviousness. The other references adds nothing to the shortcomings of Kunimoto.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach a chassis; a battery bay formed in the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly including a first plurality of batteries and having a mating surface member including a first pattern for mating engagement with a second subassembly including a second plurality of batteries and having a mating surface member including a second pattern, which is an inverse pattern to the first pattern, the patterns supporting battery cells within the subassemblies and also resisting relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpерmissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

PATENT

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Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claim 51 and its respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 51-54 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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